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EXAMINER

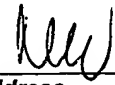
NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/648,532	Applicant(s) EMODI ET AL	
	Examiner CUONG H. NGUYEN	Art Unit 3661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is FINAL: 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28, 57 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. This Office Action is the answer to the communication received on 7/26/2004; which paper has been placed of record.

2. Claims 1-28, 57-58 are pending in this application.

Claims 1-28 are elected without traverse on 12/17/2003 for examination.

Response

3. Based on the applicants' argument, the new grounds for rejections are applied to the pending claims to show that claimed limitations are not inventive; therefore, the arguments for old rejections are moot.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, and 57-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Bro (US Pat. 5,722,418).

Bro discloses an apparatus for storing predetermined multimedia information (see Bro, Fig.1), comprising:

a telephony platform (see Bro, Fig.1 ref. 24 & 6:1-10); and

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a storage location coupled to said telephony platform, wherein said storage location stores predetermined multimedia information (see Bro, Fig.1, ref.16 - software inherently being stored in a storage device/location such as a ROM, RAM, a hard-disk, a floppy disk, an optical storage device .etc.).

Please note that claiming: means for managing, means for storing messages, means for converting electrical signals, and means for generating control signals (i.e., Bro teaches about a converter to converting a signal generating from a telephone keypad in Fig.1. Bro inherently teaches about interconnections among components of Fig.1 (i.e., electronics/electrical paths between means for managing (with a COMPUTER 32), means for storing messages (in a DATABASE 12), means for converting (DIGITAL/TELEPHONE TONE SIGNAL CONVERTER 18), and means for generating control signals (to COMPUTER 16) - these "backbone" are fundamental components/paths/buses in electronic circuits (see Bro, Fig.1).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the

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invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

5. Claims 1, and 57-58 are rejected under 35 U.S.C. § 102(e) as being anticipate by **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313).

Ellis et al. teach an existing system of a multi-media provider for storing predetermined multimedia information, comprising: a telephony platform; and a storage location coupled to said telephony platform, wherein said storage location stores multimedia information (such as video and audio) (see Ellis et al., Fig. 46, pp. 17-18 para. 0210, and page 19 para. 0220).

Please note that claiming: means for managing, means for storing messages, means for converting electrical signals, and means for generating control signals to be received at a platform (i.e., Ellis et al. teach of a remote control to converting a signal generating from a telephone keypad, or a signal generated from a TV remote control keypad in Fig.1 - ref. 31, that electronic signal is received by IR RECEIVER (ref.29)). Ellis et al., inherently teach about interconnections among components (i.e., electronics/electrical paths between means for managing, means

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for storing messages, means for converting, and means for generating control signals - these claimed "backbone" are fundamental components/paths/buses in electronic circuits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 25-28, 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare et al.** (US Pat. 6,343,115).

The rationales and reference for a rejection of claim 1 are incorporated.

A. Re. to claim 2: Foladare et al. also teach about:

- a second storage location coupled to said first telephony platform, wherein said first telephony platform receives a multimedia command from an access device of a user, (see Foladare et al., Fig.1, ref. 116, and the abstract), wherein said first storage location and said second storage location store multimedia information, wherein a first multimedia portion of said predetermined multimedia information is stored in said first storage location and a second multimedia portion of said

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predetermined multimedia information is stored in said second storage location, said first telephony platform selectively reproduces one of said first multimedia portion and said second multimedia portion as a selected multimedia portion based on said at least one multimedia command, and wherein said first telephony platform outputs said selected multimedia portion to said access device.

B. Re. to claim 57-58: Foladare et al. also describe functional components that make up claimed apparatus - those claims 56-57 read-on the functions of Foladare et al.'s system (i.e., functions done by Foladare's microprocessor, memory devices, and a certain software to perform those functions; Foladare et al. also provide a "high-speed" connection in their system (please note that there is no definition for "high-speed" in the claim - this is a term-of-degree to be compared to "a standard speed" that is not revealed).

C. As to claim 25: The rationales and reference for a rejection of claim 2 are incorporated.

Foladare et al. teach a system/an apparatus that having capabilities of receiving/sending an information command; and wherein a telephony platform outputs a message to access devices (see Foladare, Fig.1).

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It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., and capabilities of Foladare's system in handling multi-media signals (voice & text) since Foladare further teaches a system to receive a voice signal, storing/saving it in database, converting/transforming it to an understandable/ readable format corresponding to what Foladare's system design, and outputting/ forwarding said (converted) understandable/readable signal.

D. As to claim 26: The rationales and reference for a rejection of claim 2 are incorporated.

Foladare et al. teach an apparatus that having capabilities of an access command comprises a multiple user session command, and wherein a telephony platform connects different users (see Foladare, Fig.1); therefore, that read-on the claimed language.

Claim 26 phrases: "with access devices of other users who are interested in topics relating to said selected multimedia portion so that said user and said other users can communicate in a multiple user session", the examiner respectfully submits that a claim directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function "even if not directly disclosed", it

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anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

E. As to claims 27-28: The rationales and references for a rejection of claim 26 are incorporated.

Foladare et al. also teach a telephone party line in an Internet environment for a multiple-user (see Foladare, Fig.1).

F. As to claim 28: Ellis et al., and Foladare et al. do not disclose that a multiple-user session corresponds to a chat room.

However, the examiner respectfully submits that a limitation on a claim can broadly be thought as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful structure/apparatus, or properties of the claimed invention will not serve as a limitation. See *In re Gulack*, 217 USPQ 401 (CAFC 1983), *Ex parte Carver*, 227 USPQ 465 (BdPatApp&Int 1985) and *In re Lowry*, 32 USPQ2d 1031 (CAFC 1994) where language provided certain limitations because of specific relationships required by the claims, ("multiple user session corresponds to a chat room" are not functionally interrelated to make-up said claimed apparatus).

It would have been obvious to one with ordinary skill in the art at the time of the invention to suggest that a

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combination of Ellis et al., and Foladare et al.'s apparatus would be used as a multiple-user session corresponds to a chat room.

7. As to claim 3: It is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare et al.** (US Pat. 6,343,115).

The rationales and references for a rejection of claim 2 are incorporated.

Ellis et al. also disclose that multimedia information comprises music information (see Ellis et al., Fig.46).

8. As to claim 4: It is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare et al.** (US Pat. 6,343,115), and further in view of **Barbara et al.** (US Pat. 5,926,789).

The rationales and references for a rejection of claim 3 are incorporated.

Ellis et al., and Foladare et al. do not expressly disclose about music tracks.

However, Barbara et al. teach that feature (see Barbara et al., 6:1-14 wherein "an audio track" is clearly a musical track).

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., Foladare et al. and Barbara et al. to define communicate

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information are also music tracks because Barbara et al., define a location to retrieve a specific music which is implemented in Ellis and Foladare et al.'s systems.

9. As to claim 5: It is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis** et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare** et al. (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), and further in view of Aktas et al. (US Pat. 6,459,776).

The rationales and references for a rejection of claim 4 are incorporated.

Ellis et al., and Foladare et al. do not expressly disclose a first mailbox and a second mailbox in their apparatus.

However, Aktas et al. teach those features (see Aktas et al., claim 15).

Foladare et al. do not expressly disclose about a navigating menu.

However, Ellis et al., or Barbara et al. teach that feature (see Ellis et al., Fig.19; or see Barbara et al., 6:21-30, wherein a user can make an on-screen selection).

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., Foladare et al., Aktas et al., and Barbara et al. to generate an apparatus having a navigating menu and different mailboxes because this would give flexible selections for a user, and also

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a capability of comfortable navigating a menu to a user for a selection.

10. As to claims 6-7: They are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare et al.** (US Pat. 6,343,115), in view of **Barbara et al.** (US Pat. 5,926,789), and further in view of **Aktas et al.** (US Pat. 6,459,776).

A. Re. to claim 6: The rationales and references for a rejection of claim 5 are incorporated.

Ellis et al., Foladare et al., Barbara et al., and Aktas et al. do not expressly disclose an apparatus wherein inputs comprise artist name, album name, and type of music of a music track.

However, these claimed differences are only found in the non-functional descriptive material and are not functionally involved in the claimed apparatus recited. The artist name, album name, and type of music of a music track would be "information" regardless of what kind of specific data. Thus, this "descriptive material" limitation will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use Ellis et al., Foladare et al., Barbara et al., and Aktas et al. to input any type of data or any type of content. because such data does not functionally relate to the apparatus claimed (not changing a function of "inputting"), and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

It would have been obvious to one with ordinary skill in the art at the time of the invention to understand that the combination of Ellis et al., Foladare et al., Barbara et al., and Aktas et al. would generate an apparatus with structural components as claimed because a limitation on a claim can broadly be thought as its ability to make a meaningful contribution to the definition of the invention in a claim.

B. As to claim 7: This claim is rejected on obviousness as claim 6 because claimed music tracks contain non-functional descriptive material for an apparatus claim (i.e., a specific album/an album's name).

11. As to claims 9-10, and 12-13: They are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of Foladare et al. (US

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Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), and further in view of Aktas et al. (US Pat. 6,459,776).

The rationales and reference for a rejection of claim 7 are incorporated.

Ellis et al., and Foladare et al. teach a structural system in that a command controls/instructs a telephony platform (e.g., see Foladare et al., Fig.1).

Ellis et al., and Foladare et al. do not expressly disclose about a "purchase" command instructs said telephony platform to have a copy of said album downloaded/mailed to a user's address.

However, executing a purchasing command "to have a copy of said album mailed to a user's postal address" is an intent of use of claimed apparatus, thus this phrase contains a well-known limitation which is not an inventive concept. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., Foladare et al., Aktas et al., and Barbara et al. to generate Foladare et al.'s system with an intend of use as "to have a copy of said album mailed to a user's postal address" because this would be merely a specific application of a user that is already well-known.

12. As to claim 14. It is rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al. (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of Foladare et al. (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789).

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The rationales and reference for a rejection of claim 4 are incorporated.

Ellis et al., or Foladare et al. do not expressly disclose that about a multimedia command is a save command, wherein said first music track corresponds to said selected multimedia portion, wherein, after selecting said first music track, said user saves first data corresponding to said first music track in a user memory portion coupled to said at least said first telephony platform by inputting said save command, and wherein said user memory portion is assigned to said user.

However, claiming that "a command is a save command" would be obvious for that claimed apparatus because cited references' structure are capable to perform "a save command" which is a fundamental feature for most computer's applications; further Ellis et al. perform a saving after selecting which read-on the claimed action of "wherein, after selecting said first music track, said user saves first data corresponding to said first music track in a user memory portion coupled to said at least said first telephony platform by inputting said save command, and wherein said user memory portion is assigned to said user".

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., Foladare et al., and Barbara et al. because their combinations

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have all structural components that make-up the claimed apparatus; that apparatus would perform a save command.

13. As to claims 8, 11, 15-19: They are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare et al.** (US Pat. 6,343,115), in view of **Barbara et al.** (US Pat. 5,926,789), and in view of **Kelkar et al.** (US Pat. 6,182,128).

The rationales and references for a rejection of claim 14 are incorporated.

Ellis et al., Foladare et al. and Barbara et al. do not expressly disclose that first data are music data/pointer data of a first music track.

However, Kelkar et al. disclose that music data are indexed (by music tracks); therefore, first track can be used as a pointer for retrieving - (see Kelkar et al., 4:55 to 5:4).

It would have been obvious with one of ordinary skill in the art to combine Ellis et al., Foladare et al., Barbara et al., and Kelkar et al. to suggest that first music data are belongs to a first music track because the order of input data are maintained with the order of track for easy recognition; furthermore, this "order" is a non-descriptive material for an apparatus claim that does not contribute to a physical structure of that claimed apparatus; similarly, additional save commands

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can be used for additional music tracks - this is obvious by repetitions.

As to claims 8, 11, 18-19: These apparatus claims contain multimedia command, purchasing commands.

The rationales and references for obviousness rejection or claim 17 are incorporated.

Ellis et al., suggest a selection to purchase a particular movie channel (see Ellis et al., Fig.26).

Claim 19 comprises a purchasing command and a telephony platform (please note that the following claimed language does not contribute much weight - as a proper limitation of this "apparatus" claim - because it comprises an action/step/function not comprising "a physical component" that make up the claimed apparatus: "instructs said at least said first telephony platform to have a copy of said customized album mailed to a postal address of said user or downloaded to a computer network address of said user").

These claims are rejected on obviousness as claim 6 because claiming a non-functional descriptive material in an apparatus claim, and the act of "inputting data" is obvious for any e-commerce transaction (e.g. a multimedia command is a purchasing command); furthermore, the actions of saving, selecting are merely functional descriptive materials that not contributing additional structural components to limiting an apparatus claim. Cited references are capable to perform these claimed functions.

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14. As to claim 20: It is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare et al.** (US Pat. 6,343,115), in view of Barbara et al. (US Pat. 5,926,789), and in view of Kelkar et al. (US Pat. 6,182,128).

The rationales and reference for a rejection of claim 17 are incorporated.

Ellis et al., Foladare et al. and Barbara et al. do not expressly disclose that a multimedia command comprises a radio playback command (please note that for a proper limitation of this "apparatus" claim, the following claimed language does not contribute much weight because it comprises an action/step/function not "a structural components" that make up the claimed apparatus: "and wherein said at least said first telephony platform sequentially outputs said saved tracks to said access device in response to said radio playback command").

However, Kelkar et al. suggest that playback actions (see Kelkar et al. 6:22-35).

It would have been obvious with one of ordinary skill in the art to combine Ellis et al., Foladare et al., Barbara et al., and Kelkar et al. to suggest those radio-button functions as convenient controllable features of users.

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15. As to claims 21-24: They are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ellis et al.** (PGPUB-DOCUMENT-NUMBER: 20030188313), in view of **Foladare et al.** (US Pat. 6,343,115), further in view of Stokes (US Pat. 4,870,515).

The rationales and reference for a rejection of claim 2 are incorporated.

A. As to claim 21: Ellis et al., or Foladare et al. do not expressly disclose that a multimedia command comprises a forwarding command.

However, Stokes teaches that feature (Stokes disclose, "Also shown are appropriate control push buttons 70 for effecting play, record, fast forward, and pause modes, and a battery compartment 72", and Stokes also discloses: "When a particular *music track* is selected, the circuit 110 causes the deck 36 or player 40 to fast-forward until the position data agrees with the counted pulses provided from the pulse circuit 132" (please note that for a proper limitation of this "apparatus" claim, the following claimed language does not contribute much weight because it comprises an action/step not "physical components" that make up the claimed apparatus: "a telephony platform forwards a selected multimedia portion to a second access device of a second user in response to a forwarding command" is already actions that are within abilities of Ellis et al. and Foladare's systems). Stokes obviously teaches an apparatus to perform a forwarding command in above-cited paragraph.

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It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., Foladare et al. and Stokes to receive a forwarding command to Ellis et al., Foladare et al. 's platforms to process desired actions because Ellis et al. and Foladare et al.'s systems have interactive capabilities.

B. As to claim 23: Stokes also teaches an apparatus comprises a structure to perform forwarding command.

It would be obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., Foladare et al. and Stokes to receive a forwarding command to Foladare et al. 's platform to process because claim 23's language should be distinguished from cited prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the cited prior art is capable of performing the claimed function "even if not directly disclosed", it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

C. As to claims 22, 24: Foladare et al. obviously teach a system/an apparatus that having a distribution list (merely a non-functional descriptive material, just information), and obviously including/having claimed capabilities of "wherein said second

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user is part of a distribution list of a plurality of recipient users, and wherein said distribution list has been created by said user and stored in said at least said first telephony platform prior to inputting said forwarding command") ;

(please note that the above claimed language does not contribute much weight because it comprises an action/step not "a physical components" that make up the claimed apparatus.

It would have been obvious to one with ordinary skill in the art at the time of the invention to combine Ellis et al., Foladare et al. and Stokes to receive a forwarding command to Foladare et al. 's platform to process because claimed "a distribution list of a plurality of recipient users, and wherein said distribution list has been created by said user and stored in said at least said first telephony platform prior to inputting said forwarding command" are functions that Foladare and Stokes' system would be able to performed.

Conclusion

16. Claims 1-28, 57-58 are not patentable.

17. Note: Please note that applicants are claiming an apparatus in pending claims 1-28, 57-58; therefore, any claiming of functional language should then be limited to an apparatus as to opposed to a process or method.

Because apparatus claims cover structures of a machine. A "use" can only be claimed by claiming the use as a process. See *In re Papesch*, 315 F.2d 381, 384, 137 USPQ 1084, 1088 (CCPA

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1963). Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). When interpreting functional language, if the prior art is capable of performing the claimed function "even if not directly disclosed", it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997).

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, Thomas G. Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Cuong H. Nguyen

CAN
CUONG H. NGUYEN
Primary Examiner
Art Unit 3661